

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 112, are respectfully requested in light of the remarks which follow.

I. Amendments to the Claims

By the foregoing claim amendments, claims 1, 3, 13, 17, 18, 22-25, and 29 have been amended, and claims 19-21 have been canceled.

The amendments to the claims, including cancellation of claims, have been made without prejudice or disclaimer to any subject matter recited or canceled herein. Applicants reserve the right to file one or more continuation and/or divisional applications directed to any canceled subject matter. Support for the amended claims can be found throughout the originally filed application. No new matter has been added, and entry of the foregoing amendments of the above-identified application are respectfully requested.

II. Response to Objection to the Specification

The specification has been objected to for allegedly including terms which are not clear, concise, and exact. Applicants respectfully traverse this objection.

Nonetheless, to expedite prosecution in the present application, Applicants submit herewith a substitute specification including "clarifying" amendments throughout the disclosure.

Applicants respectfully request reconsideration and withdrawal of the objections to the specification.

III. Response to Objection to the Claims

Claims 19-22 have been objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully traverse this objection.

Claims 19-21 have been canceled, rendering this objection moot with regard to those claims.

In addition, to expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, claim 22 has been amended to depend from claim 17 rather than from claim 21. Applicants submit that claim 22 further limits the subject matter of claim 17.

Applicants respectfully request reconsideration and withdrawal of the objections to the claims.

IV. Response to Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-30 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. Applicants respectfully traverse this rejection.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, the claims have been amended such that the control means is enabled to operate in a body where a photosensitizer is activated. Furthermore, claim 13 has been amended to recite a step for calculating a peak intensity of light.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

V. Response to Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-30 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicants respectfully traverse this rejection.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, the claims have been amended as set forth above. Applicants submit that the claims as amended particularly point out and distinctly claim the subject matter Applicants regard as the invention. In particular, claim 1 has been amended by replacing the phrase "almost not activated" with "not activated," as supported at least at page 7, lines 6-10 and 26-31, of the specification.

Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

VI. Response to Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4-6, 10-25 and 29-30 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Parker et al. (U.S. Patent No. 4,592,361). Applicants respectfully traverse this rejection.

It is well established that for prior art to be anticipatory, every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Applicants submit that Parker et al. fails to satisfy this requirement, for at least the following reasons.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, the claims have been amended as set forth herein. In particular, claims 1, 13 and 29 have been amended to recite a control means for calculating a peak intensity of the light based on an experimentally estimated relationship between the peak intensity of light and a therapeutic depth, as supported at least at page 17, lines 10-15, of the present specification. Applicants submit that Parker et al. does not teach or even this feature of the present claims.

In addition, claim 3 has been amended to recite a peak intensity ranging from 10 kW/cm² to 10 MW/cm², as supported at least at page 18, lines 25-31, of the present specification. Applicants submit that Parker et al. does not teach or even suggest the composing element of setting the upper limit of the peak intensity for superficial lesion preserving therapy.

Furthermore, claim 17 has been amended to recite calculating an irradiation condition of the light based on measuring the result of rate of cell death to depth in each pulse energy density, which is supported at least in the disclosure related to Figs. 9-11 of the present specification. Applicants submit that Parker et al. does not teach or even suggest such a calculation.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102 rejection.

VII. Response to Claim Rejections Under 35 U.S.C. § 103

A. Claim 3 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Parker et al. as applied to claim 1 above and further in view of Prasad et al. (U.S. Publication No. 2003/0022105).

B. Claims 7-9 and 26-28 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Parker et al. as applied to claims 1 and 17 above and further in view of Selman (U.S. Patent No. 5,514,669).

Applicants respectfully traverse each of the rejections under 35 U.S.C. § 103(a).

For at least the reasons set forth above, Parker et al. does not teach or suggest the subject matter of the present claims. Furthermore, the additional references cited by the Examiner do not remedy the serious deficiencies of Parker et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejections.

VIII. Conclusion

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney so that prosecution of this application may be expedited.

Respectfully submitted,

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